

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sugio MAKISHIMA et al.

Application No.: 09/922,869

Confirmation No.: 8515

Filed: August 7, 2001

Art Unit: 2624

For: PRINT SYSTEM AND METHOD OF
CONTROLLING OPERATION OF SAME

Examiner: K. Y. Poon

REPLACEMENT
APPLICANT'S BRIEF IN REPLY TO THE EXAMINER'S ANSWER

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following brief is submitted to address the issues raised in the Examiner's Answer mailed September 4, 2009. As noted by the Examiner, the Examiner's Answer of September 4, 2009 is based on the Replacement Appeal Brief dated June 25, 2007 and an entered Amendment After Final dated June 14, 2007. Subsequently, this appeal is based on claims provided in the Claims Appendix of the June 25, 2007 Replacement Appeal Brief and related arguments and the June 14, 2007 Amendment After Final.

As the September 4, 2009 Examiner's Answer contains identical arguments as in the previous Examiner's Answer mailed September 18, 2007 (which was in response to the June 25, 2007 Replacement Appeal Brief), except for an indication that the statement of the status of the claims ("Status of Claims") contained in the brief of 6/25/07 is correct and that the amendment after final rejection filed on 6/14/07 has been entered ("Status of Amendments After Final"), Appellant's provide herewith arguments that were previously submitted in a Replacement Reply Brief dated November 9, 2007. Those arguments are repeated below for purposes of convenience.

The Examiner's Answer mailed September 4, 2009, is difficult to interpret. As discussed below, it contains inconsistent arguments and relies on documents that are not of record to support the rejection of some or all claims. Furthermore, it appears that the Examiner's Answer includes new grounds of rejection in the "Response to Arguments" section. However, these are not specifically designated as new grounds of rejection and appear to be inconsistent with the rejections presented in the "Grounds of Rejection" section of the Examiner's Answer. The following Reply addresses only the rejections that are designated as rejections in the Examiner's Answer.

If the Board finds that new grounds of rejection are raised by the Examiner's Answer, it is respectfully requested that the Board remand this application to the examiner for a Supplemental Examiner's Answer pursuant to 37 C.F.R. 41.50. If the Supplemental Examiner's Answer specifically designates new grounds of rejection, Applicant will consider possible claim amendments to overcome such any new grounds of rejection that are identified.

THE EXAMINER'S RELIANCE ON OFFICIAL NOTICE IS IMPROPER

The final Office Action and section 9 of the Examiner's Answer both provide that "it is well known in the art that things that are united solidly probably are under a same housing." This statement is presented in support of the rejection of claims 1-3, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg. Applicant challenged this reliance on Official Notice in the Appeal Brief. In the Section 10 of the Examiner's Answer, the examiner argues that he is not taking Official Notice of any fact but is relying on definitions from the web site www.dictionary.com to support the rejection. These definitions have not previously been mentioned, and copies of the definitions relied on are not of record. It is therefore respectfully submitted that this evidence cannot be relied upon to support the rejection of any claims.¹ It is further submitted that a proper basis for taking Official Notice has not been established, and that all rejections based on the above-quoted statement should be withdrawn.

¹ To the extent evidence not of record is given any weight, it is noted that www.dictionary.com does not include a definition of "solidly." Only a definition of "solid" could be found by Applicant's representative, and of the 17 meanings of this word, the one selected by the examiner does not appear to be the most relevant to the present facts.

The Examiner's Answer also includes the statement "the most efficient method of entering numbers (phone numbers) or letters (email address) is by using keypad...." It is respectfully submitted that this statement cannot be established by Official Notice. In fact, it would seem more efficient to enter letters by using a standard computer keyboard than by using the keypad of a telephone. Applicant therefore challenges the examiner's reliance on Official Notice to establish the truth of the above statement and submits that all rejections based on this statement should be withdrawn.

A MOTIVATION FOR MODIFYING TAMURA STILL HAS NOT BEEN PROVIDED

The final Office Action and section 9 of the Examiner's Answer reject claims 1-3, 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg. Applicant argued in the Appeal Brief that a proper motivation for modifying Tamura in view of these secondary references had not been provided. In section 10 of the Examiner's Answer, the examiner argues for the first time that the motivation for modifying Tamura comes from Tamura itself. This statement and the discussion that follows suggests the examiner may be making an anticipation rejection under 35 U.S.C. 102(b) based on Tamura or a new single reference obviousness rejection under 35 U.S.C. 103(a) based on Tamura. However, after presenting these arguments, page 10 of the Examiner's Answer refers once again to Parulski and Attenberg. It is not clear what modification to Tamura is being suggested and what role Parulski and Attenberg play in the rejection.

If the claims are still being rejected based on Tamura in view of Parulski and Attenberg, Applicant maintains that a proper motivation for combining these references has not been provided. If the examiner is raising a new rejection, it is respectfully submitted that the application should be remanded for a Supplemental Examiner's Answer that specifically designates any such new ground of rejection.

CONCLUSION

For the above reasons and the reasons presented in Applicant's Appeal Brief, the withdrawal of the rejections of claims 1-3 and 10-13 is earnestly solicited. If the examiner wishes to raise new grounds of rejection or rely on evidence not in the record, it is respectfully

requested that the present application be remanded and prosecution reopened with appropriate guidance from the Board.

Dated: October 28, 2009

Respectfully submitted,

By Robert Doans #48222
Michael R. Cammarata *Robert Doans*
Registration No.: 39,491
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant